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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,390	11/20/2003	Ronald F. Palermo	10670013010202	9732
37211	7590	06/19/2007		
BASCH & NICKERSON LLP 1777 PENFIELD ROAD PENFIELD, NY 14526			EXAMINER WOLLSCHLAGER, JEFFREY MICHAEL	
			ART UNIT 1732	PAPER NUMBER
			MAIL DATE 06/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,390

Applicant(s)

PALERMO ET AL.

Examiner

Jeff Wollschlager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 28, 2007 has been entered.

Response to Amendment

Applicant's amendment to the claims filed March 28, 2007 has been entered. Claim 1 is currently amended. Claims 14-19 were previously canceled. Claim 20 is new. Claims 1-13 and 20 are pending and under examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 20 recite the decorative aggregate is "a non-cementitious decorative aggregate". There does not appear to be adequate support in the instant disclosure for this limitation in the claims. The specification provides support for various types of

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decorative aggregates, but does not appear to provide support to exclude cementitious based decorative aggregates. Further, claim 20 recites substantially similar process steps to those found in claim 1, but employs the transitional phrase "consisting of". There does not appear to be adequate support in the instant disclosure for this limitation in the claim. The specification provides support for the comprising language employed in claim 1, but does not appear to provide support to exclude other steps utilized in connection with the claimed process steps to produce the claimed monolithic floor.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, 7-10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Patent 6,033,146) in view of Danielsson (U.S. Patent 4,281,496) or Harvey (US 6,568,146).

Regarding claims 1 and 20, Shaw et al. teach a method for forming a decorative concrete material containing integrated aggregate with the following steps: preparing and forming the region upon which the monolithic concrete floor is to be poured (col. 3, lines 31-33); contiguously pouring concrete throughout the formed region (col. 3 lines 42-45); striking off and floating the concrete to effectively densify the concrete (col. 3, lines 53-55 and 57-60); implicitly allowing the concrete to cure to a semi-stiff state because the concrete is intrinsically semi-stiff as evidenced by col. 4, lines 14-16 and due to the fact that time has passed since the completion of the floating step. Next, to the finished, generally planar surface, a quantity of decorative aggregate is disbursed over the semi-stiff concrete surface (col. 3, line 65 – col. 4, line 5) and is then integrated into the upper surface of the semi-stiff concrete (col. 4, line 17-19). The concrete with the integrated aggregate is then partially cured (col. 4, lines 27-30), and the surface is washed and brushed such that no more than five percent of the particulates are removed (col. 4, lines 36-50). The concrete is then fully cured and washed and undergoes additional grinding and is polished (col. 4, lines 55-65) to provide a generally planar and smooth monolithic concrete floor.

Shaw et al. do not perform a traditional grinding step until after the floor has fully cured. However, Danielsson teaches an analogous method for forming a concrete floor where the grinding is performed after the floor is hardened/partially cured, but prior to the floor being fully cured to produce a floor comprising uniformly exposed aggregate over the top of the concrete (Abstract; col. 1, lines 56-64; col. 2, lines 17-22; col. 3, lines 46-52; col. 6, lines 47-52; col. 7, line 64 – col. 8, lines 11-19). Alternatively, Harvey teaches an analogous method of manufacturing a decorative cementitious floor wherein the floor containing decorative aggregate is partially cured for 12 to 48 hours and then ground to a smooth finish (col. 3, lines 36-67).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have performed the grinding step disclosed by Shaw et al. before the floor was fully cured for the purpose as taught by Danielsson, of improving the efficiency of the grinding step (col. 8, lines 11-19) or for the purpose as suggested by Harvey of grinding a floor containing aggregate to produce a smooth finish in an art recognized equivalent manner (col. 3, lines 58-68).

As to claim 2, Shaw et al. teach the aggregate particulate is approximately 3/8", which is approximately 9 mm (col. 4, line 5).

As to claims 3-5, Shaw et al. teach the aggregate comprises naturally occurring materials such as seashells and various metals as well as man-made materials such as glass and composite materials (col. 4, lines 1-5).

As to claim 7, Shaw et al. teach the concrete may be colored (col. 3, line 50).

As to claims 8-10, Shaw et al. teach that the top surface may be treated with a hydrolyzed alkali silica solution sealer after the floor is completed which results in the formation of an insoluble silicate structure on the surface of the concrete (col. 4, line 65 – col. 5, line 15).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Patent 6,033,146) in view of Danielsson (U.S. Patent 4,281,496) or Harvey (US 6,568,146), as applied to claims 1-5, 7-10 and 20 above, and further in view of Darrow et al. (US 6,780,369).

As to claim 6, Shaw et al. do not explicitly state that the semi-stiff state is determined by a one-quarter inch depression resulting from an applied normal force of between about 4 and 5 pounds per square inch. However, Shaw et al. teach a semi-stiff state of the concrete such that the particulate is prevented from impressing into the surface of the concrete before it is so desired (col. 4, lines 14-16). Whereas Shaw et al. employ the same claimed material in the

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same claimed way under the same claimed process conditions it follows that the semi-stiff state disclosed by Shaw et al. is the same as the semi-stiff state recited in the claim. It is further noted that the claim does not appear to define a manipulative step.

Additionally, Darrow et al. disclose that it is conventional in the art to allow the concrete to reach a certain level of firmness/stiffness prior to finishing (col. 8, lines 23-62) and that prior to "further floating operations" a test of having a finisher step on the floor should result in a depression of $\frac{1}{4}$ " to $\frac{3}{8}$ " (col. 10, lines 11-26).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have combined the teaching of Shaw with Darrow et al. and to have monitored and controlled the level of firmness of the concrete prior to further finishing steps for the purpose of effectively finishing the concrete floor, as is routinely practiced in the art.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Patent 6,033,146) in view of Danielsson (U.S. Patent 4,281,496) or Harvey (US 6,568,146), as applied to claims 1-5, 7-10 and 20 above, and further in view of Surface Preparation (IDS document, 2001).

As to claim 11, the combination teaches the method of claim 1 as set forth above. Further, Harvey teaches a progressive grinding process to yield a fine surface using between 100 to 3,000 grit sanding wheels (col. 3, lines 62-67). The combination does not disclose the specific diamond heads/pads as claimed.

However, the Surface Preparation document illustrates the employment of diamond disks for grinding concrete (page 3 and 6 of the document). Further, it is noted that one having ordinary skill would have selected and optimized the grit and types of diamond/sandpaper

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depending on the type of aggregate used, the degree of concrete cure, and the required degree of surface smoothness and shine.

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have employed conventional grinding means to progressively grind the surface of the concrete to produce a desired surface smoothness. The combination suggests the specific selection of the means would have been readily optimized by the artisan.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Patent 6,033,146) in view of Danielsson (U.S. Patent 4,281,496) or Harvey (US 6,568,146) and further in view of Surface Preparation (IDS document, 2001), as applied to claim 11 above, and still further in view of Jones (U.S. Patent 6,454,632).

As to claim 12, the combination teaches method of claim 11 as set forth above. Shaw et al. do not teach all the limitations of claim 12. However, Jones et al. teach applying a surface treatment to the polished upper surface, where the surface treatment is a chemical reactive concrete stabilizer providing a densified upper surface (Abstract; col. 2, lines 50 – col. 3, line 25).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have employed the surface treatment disclosed by Jones et al. in the method taught by Shaw for the purpose, as taught by Jones et al. of hardening/densifying and polishing a concrete surface (Abstract).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Patent 6,033,146) in view of Danielsson (U.S. Patent 4,281,496) or Harvey (US

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6,568,146), as applied to claims 1-5, 7-10 and 20 above, and further in view of Chiuminatta et al (5,086,750)

As to claim 13, the combination teaches the method of claim 1 as set forth above. Shaw et al. is silent about the conventional practice of scoring the semi-cured floor to facilitate stress relief. However, Chiuminatta et al. provide explicit teaching where a diamond saw is employed to score a semi-cured concrete floor (Abstract; col. 1, lines 49-63; col. 3, lines 8-15; col. 5, lines 36-38).

Therefore it would have been *prima facie* obvious to employ the scoring technique disclosed by Chiuminatta et al. while practicing the method of Shaw et al. for the purpose of facilitating uniform stress relief such that the provided expansion or contraction joints prevent the concrete from cracking undesirably

Response to Arguments

Applicant's arguments filed March 28, 2007 regarding the rejection over Phillips are moot in view of the amendment to the claims.

Applicant's arguments filed March 28, 2007 regarding the rejection over Shaw and Danielsson have been fully considered, but they are not persuasive.

Applicant's arguments appear to be on the following grounds:

1. Neither Shaw nor Danielsson teach the required limitation of grinding the upper surface of the partially cured concrete with the integrated aggregate therein.

The arguments are not persuasive for the following reason:

1. It is the combination of Shaw with Danielsson as set forth in the section 103 rejection above that suggests the claim limitation. Shaw teaches grinding the upper surface of cured concrete with the integrated aggregate therein. Danielsson teaches that the efficiency of

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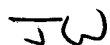
grinding concrete can be increased by grinding the concrete before it is finally cured (i.e. partially cured). The combination suggests modifying Shaw's method to grind the concrete with the integrated aggregated therein while it is only partially cured. Further, the examiner notes that an alternative rejection in view of Harvey has been made as set forth above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeff Wollschlager
Examiner
Art Unit 1732

June 13, 2007



CHRISTINA JOHNSON
SUPERVISORY PATENT EXAMINER

